46. (NEW) A composition comprising the synthetic oligonucleotide of claim 26 and a pharmaceutically acceptable carrier.

47. (NEW) A composition comprising the synthetic oligonucleotide of claim 34 and a pharmaceutically acceptable carrier.

48. (NEW) A composition comprising the synthetic oligonucleotide of claim 41 and a pharmaceutically acceptable carrier.

REMARKS

I. Introduction

In response to the Office Action dated September 17, 2001, claims 1-25 have been cancelled, and 26-48 have been added. Claims 26-48 remain in the application. Reconsideration of the application, as amended, is requested.

II. Claim Amendments

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and introduce no new matter. Support for new claims 26-48 can be found in the originally-filed application as follows.

New claim 26 is supported by previous claims 1 and 4, and the specification as originally filed at page 14, lines 28-32, and at page 15, lines 5-6.

New claims 27 and 35 are supported by previous claim 1.

New claims 28-30 are supported by previous claims 7-9, respectively.

New claims 31, 34 and 41 are supported by previous claim 1 and by the specification at page 33, lines 35-36 and the Sequence Listing (see also Figs. 1A-1B and 7A-7G).

New claims 32-33 are supported by previous claims 5-6, respectively.

New claims 36-39 are supported by the specification at page 14, lines 28-32.

New claims 40 and 42 are supported by the specification at page 15, lines 5-6.

New claims 43-45 are supported by the specification at page 15, lines 21-35, and page 17, line 4.

New claims 46-48 are supported by the specification at page 16, line 32, to page 17, line 6.

III. Restriction Requirement

Applicants acknowledge that the Restriction Requirement set forth in the July 19, 2001 Office Action has been made final. Applicants have canceled claims directed to the non-elected subject matter and reserve the right to pursue the subject matter of the canceled claims in a later application.

IV. Non-Art Rejections

At page 2-3 of the Office Action, claims 2-10 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 2-9 are viewed by the Examiner as substantial duplicates of claim 1, from which they all ultimately depend, because the functional limitations added by these claims are regarded as recitations of intended utility. The reference to Figure 1B in claim 10 is asserted to render the claim indefinite.

Although the cancellation of claims 1-10 renders this rejection moot, Applicants wish to state the following for the record.

Applicants respectfully disagree with the Examiner's assertion that the functional limitations are nothing more than recitations of intended use. The recited functional limitations limit the claims to synthetic oligonucleotides meeting the recited structural limitations (e.g., C-5 methylcytosine) and that further recognize and bind an allosteric site on DCMTase and, in certain claims, inhibit DCMTase activity with the recited inhibition constant. This is distinct from a recitation of intended use, such as "a synthetic oligonucleotide for inhibiting DCMTase activity."

Applicants note that there is "nothing inherently wrong with defining some part of an invention in functional terms." MPEP §2173.05(g), *citing In re Swinehart*, 169 USPQ 226 (CCPA 1971). As stated in the cited portion of the MPEP, "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." As can be recognized and

determined by those skilled in the art, a given oligonucleotide falls within the claim if it meets both the structural and functional limitations. The skilled artisan can readily determine whether a candidate oligonucleotide meets the recited functional limitation by performing an assay such as one of the assays described in Example 2 of the specification, at pages 39-59.

V. Prior Art Rejections

At pages 3-4 of the Office Action, claims 1-9 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Froehler et al. (U.S. Patent No. 5,830,653). The cancellation of claims 1-9 renders the rejection moot.

Applicants note for the record, however, that Froehler does not teach or suggest a synthetic oligonucleotide having the features required by Applicants' claims.

VI. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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